BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

As rescanning documents *will not* correct images, please do not report the images to the Image Problem Mailbox.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,293	03/20/2001	David G. Abdallah JR.	FIRE.P9905052	2286

7590 07/08/2002

John H. Hornickel
Chief Intellectual Property Counsel
Bridgestone/Firestone, Inc,
1200 Firestone Parkway
Akron, OH 44317

EXAMINER
JOHNSTONE, ADRIENNE C

ART UNIT	PAPER NUMBER
1733	4

DATE MAILED: 07/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Acti n Summary	Applicati n No. 09/812,293	Applicant(s) ABDALLAH, DAVID G.	
	Examiner Adrienne C. Johnstone	Art Unit 1733	

-- The MAILING DATE of this communication app ars on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 March 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) *1-20,26 and 27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-25 and 28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2, 3* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-10, 26, and 27, drawn to a body ply for a pneumatic tire, classified in class 428, subclass 114.

   II. Claims 11-18, drawn to a method of making the body ply, classified in class 156, subclass 178.

   III. Claims 19 and 20, drawn to a method of building a tire incorporating the body ply, classified in class 156, subclass 133.

   IV. Claims 21-25 and 28, drawn to a tire incorporating the body ply, classified in class 152, subclass 556.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II, III and I, IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as one in which rubber is poured into a mold containing the cords.

3. Inventions IV and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the particulars of the combination (tire structure, positioning of the ply as a

body ply in the tire) show that the particulars of the subcombination are not the sole basis for patentability of the combination. The subcombination has separate utility such as a reinforcing ply in the belt, bead or sidewall of a tire or in other elastomeric composites (conveyor belts, drive belts, hoses, etc.).

4. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention III has separate utility such as a method of building a tire incorporating the body ply wherein the body ply is not made by the method of Invention II (for example, a method in which the body ply is formed by pouring rubber into a mold containing the cords). See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Thomas Kingsbury on May 23, 2002 a provisional election was made with traverse to prosecute the invention of Group IV, claims 21-25 and 28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-20, 26, and 27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the subject matter of claims 23 and 25 ("substantially" parallel to the axis ofthe tire) is not yet recited in the specification.

Claim Objections

8. Claims 21-25 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Tire claims 21 and 24 do not further limit the body ply structure of claim 1.

To overcome this objection applicant should rewrite claims 21 and 24 in independent form.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Application 6-115308 with translation (cited by applicant).

See the embodiment of Figure 6. As to claims 21-23, one of ordinary skill in the art would have understood the JP '308 carcass (body) ply to have basic carcass ply structure including spliced edges forming an axially extending seam.

11. Claims 21-25 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyazono et al. (5,855,703).

See Examples 4 and 7. As to claims 21-23, one of ordinary skill in the art would have understood the JP '308 carcass (body) ply to have basic carcass ply structure including spliced edges forming an axially extending seam. As to the number of cords per row in claim 28, the close structural correspondence (two layers, cord diameter and spacing in the claimed ranges) between

the carcass plies in the Miyazono et al. tire and the claimed tire provide a reasonable basis for inferring that the Miyazono et al. carcass ply would also meet the claimed broad absolute value range of about 50 to about 600 cords per row in the ply; burden therefore shifts to applicant to show lack of inherency (see the case law in MPEP 2112 and 2112.01).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 6-115308 with translation (cited by applicant).

See paragraph 10 above: it would have been obvious to one of ordinary skill in the art to provide such basic carcass ply structure in the above tire.

14. Claims 21-23 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazono et al. (5,855,703).

See paragraph 11 above: as to claims 21-23, it would have been obvious to one of ordinary skill in the art to provide such basic carcass ply structure in the above tire; as to claim 28, it would have been obvious to one of ordinary skill in the art to provide such conventional carcass cord count in the above tire.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents anticipate or render obvious at least claims 21 and 24 but are considered at this time to be no more pertinent than the prior art already applied: Jury (1,608,102); Jahant (2,331,323); Jahant (2,441,071); and Miyazono et al. (5,766,384).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (703)308-2059. The examiner can normally be reached on Monday-Friday, 10:00AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703)308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9311 for regular communications and (703)872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Adrienne C. Johnstone
Primary Examiner
Art Unit 1733

Adrienne Johnstone
July 1, 2002